

## REMARKS

### I. Introduction

This Amendment is submitted in response to the Office Action dated October 26, 2006, having a shortened statutory period set to expire January 26, 2006, extended to February 26, 2007, and pursuant to an in-office interview with Examiner Le and Supervisory Patent Examiner Urban on February 2, 2007. The courtesies extended to Applicant and Applicant's representative during that interview are noted with great appreciation.

### II. Rejection under 35 U.S.C. § 103

In paragraph 1 of the present Office Action, Claims 1-27 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pub. No. 2002/0102988 to *Myllymaki* in view of U.S. Pub. No. 2002/0049535 to *Rigo et al* in further view of U.S. Patent No. 6,013,007 to *Root et al. (Root)*. That rejection is respectfully traversed in view of the amendments and reasoning submitted herein, and favorable reconsideration of the claims is respectfully requested.

#### A. Claims are Patentable Because Combination of References Lacks Objective Motivation or Suggestion

As set forth in MPEP 2143.01:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching requirement as a guard against using hindsight in an obviousness analysis). The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

This section of the MPEP further delineates the possible sources of motivation for a combination of prior art references as follows:

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)(The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.).

In evaluating the teachings of the prior art references, MPEP2141.03 dictates, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)

In the present application, Applicant respectfully submits that as in *In re Rouffet, supra*, exemplary Claim 1 is not rendered unpatentable by the references of record because, even assuming that each of the elements was known in the art, the combination of elements is not taught or suggested by the references of record. Specifically, the combination of elements is not taught or suggested by the nature of the problem to be solved, the teachings of the prior art references, or the knowledge of persons of ordinary skill in the art.

Turning now to the references of record, *Myllymaki* considered as a whole discloses a GPS-enabled portable wireless device that provides location-based document sorting and presentation (see, e.g., *Myllymaki*, Claim 1). *Rigo* as a whole discloses an automotive telematics system that allows mobile search, communicates location and direction in response to a query by a remote server, and presents routing information received from the remote server (see, e.g., *Rigo*, paragraphs [0023]-[0025]). *Root* as a whole discloses a GPS-enabled personal athletic performance monitor (see, e.g., *Root*, Abstract).

In support of the proposed combination of these three references, page 3 of the present Office Action states:

It would have been obvious ... to combine the teaching of Rigo into the system of Myllymaki in order to provide users querying the geographical position and direction (as suggested by Rigo paragraph 0025).

and

Therefore, it would have been obvious to one of ordinary skill in the art ... to provide the teaching of Root into the system of Myllymaki and Rigo in order to monitor the athletic performance.

In other words, the Office Action argues that the combination of each of the references would have been obvious by virtue of the additional features provided by each reference. However, the present Office Action does not provide any objective evidence that a person of ordinary skill in the art would have selected the particular features of the cited references to piece together the invention set forth in the present claims. For example, what objective evidence is of record that an ordinarily skilled artisan would attempt a combination of *Rigo's* automotive telematics system with *Myllymaki's* location-based document sorting and presentation device? Similarly, why would an ordinarily skilled artisan further combine this subcombination with *Root's* athletic performance monitor?

Applicant respectfully submits no such objective support for the combination exists, and the only teaching of record to select and combine the specified elements from these disparate systems is found in Applicant's specification and is available only by impermissible hindsight reasoning. Specifically, the prior art of record does not disclose a problem that, by its very nature, motivates or suggests the proposed combination of the cited references as a solution. Similarly, there is no citation in the present Office Action to specific teachings of the prior art references or to documentation of knowledge of persons of ordinary skill in the art that would have motivated an ordinarily skilled artisan to make the proposed combination of the cited references.

B. Claims are Patentable Because Secondary Considerations of Nonobviousness

Applicant further respectfully submits that the present claims are patentable over the references of record because of the objective evidence of nonobviousness provided herein and in the accompanying Declaration under 37 C.F.R. § 1.132. As discussed in *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997), such objective evidence of nonobviousness, although frequently termed “secondary considerations”, is to be considered as part of all the evidence when evaluating obviousness:

Indeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decisionmaker remains in doubt after reviewing the art. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39, 218 USPQ 871, 879 (Fed. Cir. 1983)(emphasis supplied).

As a first ground of evidence of nonobviousness, Applicant points out that the combination of features recited in the present claims is not taught by the prior art despite knowledge of the individual components. As reasoned by the Federal Circuit in *Arkie Lures, supra*:

It is insufficient to establish nonobviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements. Indeed the years of use of [the claimed features], without combining the properties, weighs on the side of unobviousness of the combination.

In the present case, exemplary Claim 1 recites a “mobile phone” that “determines athletic performance information at multiple of the plurality of waypoints ... and outputs at least said plurality of waypoints within the route to said wireless communication network during traversal of the route via said wireless wide-area network transceiver transmitter.” However, the prior art of record does not teach or suggest the combination of a mobile phone with an apparatus that determines athletic performance information to permit the transmission on a wireless network of during traversal of a route of an athletic activity. This is true despite the fact the first handheld mobile phone was used April 3, 1973, and the first fully automatic mobile phone system, the Nordic Mobile Telephone (NMT) system, was introduced in 1981, as evidenced by the definition

of mobile phone at www.Wikipedia.org, a copy of which is submitted herewith. Thus, for the 31 years that mobile phones were known and the 23 years that mobile telephone systems were deployed prior to the filing of the present application, there is no evidence of record that a mobile phone was combined with the other claimed elements to achieve the combination set forth in the present claims. In particular, looking specifically at *Root*, which is titled an "Athlete's GPS-Based Performance Monitor," Applicant notes that despite the fact mobile phones were well-known by March 26, 1998, the filing date of *Root*, *Root* contains no teaching or suggestion of the implementation of an athletic performance monitor on a mobile phone platform. If the combination of features recited in the present claims were obvious at the time the present application was filed, *Root* surely would have disclosed such an embodiment.

As a second ground of nonobviousness, Applicant points to the public and commercial response to the invention. "In Graham the Supreme Court explained that the public and commercial response to an invention is a factor to be considered in determining obviousness, and is entitled to fair weight. 383 U.S. at 35-36, 148 USPQ at 474." *Arkie Lures, supra*. In the present case, the accompanying Declaration demonstrates that the commercial response to the present invention uniformly was that the present invention was a matter of first impression that had not been even conceived by those most familiar with the relevant industries. For example, Jonathan E. Spinney, former Industry Solutions Marketing Manager for Location Based Services at ESRI (a GPS mapping company), states, "it was unequivocally obvious the BIM team had carved out an application niche previously unexplored or achieved by any application developer" (see, e.g., Declaration, Exhibit C). Similarly, Warren Greene, current Brand Editor at Runner's World magazine and former Gear Editor at Men's Health magazine, states that his introduction to the present invention was "the first I had heard of tracking runs, or anything for that matter, with a cell phone" (see, e.g., Declaration, Exhibit D). Chris Verbil, Applicants Engineering Manager for Qualcomm Incorporated, further states in Exhibit E of the accompanying Declaration:

The BiM Active application and service offering was unique when I first saw it. As an active runner I had been using conventional GPS devices for several years to record my training runs; this would require several intermediate manual steps to get the data into a useable format. The BiM Active application was unique in

that it not only automated data collection for the user during the activity, but simultaneously provided a single source web-based training log where all the activities would be recorded.

Thus, key technologists in the GPS mapping industry, the mobile phone industry and the fitness industry all support the non-obviousness of the claimed subject matter. Further industry validation of the innovative and non-obvious nature of the present invention is provided by the award of the Grand Prize to the present invention by the estimable panel of judges of the NavTeq 2<sup>nd</sup> Annual Global LBS Challenge (see, .e.g., Declaration, Exhibits F and G).

C. Claims are Patentable Because Combination of References Does Not Disclose Claimed Combination of Features

Applicant further submits that exemplary Claim 1 is patentable over the proposed combination of references because that combination does not teach or suggest each claimed feature. For example, the proposed combination of cited references does not teach or suggest:

a processing unit coupled to the GPS receiver and the wireless wide-area network transceiver, wherein the processing unit receives from said GPS receiver data describing a plurality of waypoints within a route of a fitness activity, determines athletic performance information at multiple of the plurality of waypoints, said athletic performance information including athletic performance information indicative of velocity and at least some of said athletic performance information being determined from the waypoints, and outputs said plurality of waypoints within the route and at least a portion of said athletic performance information to said wireless communication network during traversal of the route via said wireless wide-area network transceiver.

That is, the proposed combination of references does not teach or suggest the transmission during traversal of the route of the “said plurality of waypoints” and “at least a portion of said athletic performance information.” *Root* explicitly teaches the uploading of data from a personal performance monitor after traversal of a route via a modem or serial connection (*Root*, col. 8, lines 52-65). *Rigo* teaches communicating “geographical position and direction of travel” (*Rigo*, paragraph [0025]), but fails to disclose communicating a “plurality of waypoints” or any data that could constitute “athletic performance information.” *Myllymaki* teaches communicating at most the user’s position. Consequently, when these references are viewed in combination, that

combination does not disclose transmission during traversal of the route of “said plurality of waypoints” and “at least a portion of said athletic performance information.” Applicant accordingly submits that exemplary Claim 1, similar Claim 11, and their respective dependent claims are not rendered unpatentable under 35 U.S.C. § 103.

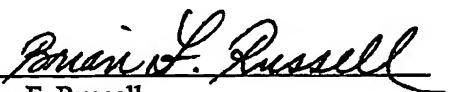
Applicant further respectfully submits that exemplary Claim 20 is not rendered unpatentable by the proposed combination of cited references because the present Office Action does not set forth a *prima facie* case of obviousness with respect to the subject matter set forth therein. In particular, the present Office Action does not allege that the combination of cited references discloses “in response to receipt of at least one route criterion including at least one of route length and route duration, automatically generating one or more routes satisfying said at least one route criterion for user selection, wherein each route represents a physical path that may be traversed by a human during a fitness activity.” The present Office Action similarly does not allege that the combination of references discloses “presenting said one or more routes for user selection” or “in response to user selection of at least one route among said one or more routes, transmitting information regarding said route to a portable fitness device.” Because no *prima facie* case of obviousness is made with respect to Claim 20, the rejection thereof is clearly not well founded and should be withdrawn.

### III. Conclusion

Having now responded to each rejection set forth in the present Office Action, Applicant believes all pending claims are now in condition for allowance and respectfully requests such allowance.

Applicant submits herewith the fee for a one-month extension of time. No additional fee is believed to be required. If, however, any additional fees are required, please charge those fees to Dillon & Yudell LLP Deposit Account No. 50-3083.

Respectfully submitted,



Brian F. Russell

*Registration No. 40,796*

DILLON & YUDELL LLP

8911 N. Capital of Texas Hwy., Ste. 2110

Austin, Texas 78759

(512) 343-6116

ATTORNEY FOR APPLICANT